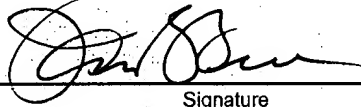


Doc Code AP.PRE.REQ

PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
		16356.723	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>12/19/05</u> Signature <u>MTH</u> Typed or printed name <u>Nishi Pasarya</u>		Application Number <u>09/313,436</u>	Filed <u>May 17, 1999</u>
		First Named Inventor <u>Springer, David S., et al.</u>	
		Art Unit <u>3622</u>	Examiner <u>Khanh H. Le</u>
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the			
<input type="checkbox"/> applicant/inventor.		Signature	
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)		James R. Bell	
		Typed or printed name	
<input checked="" type="checkbox"/> attorney or agent of record. <u>26,528</u>		512-867-8407	
Registration number		Telephone number	
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		<u>12-19-05</u>	
		Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
<input type="checkbox"/> *Total of <u>one</u> forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT  
Docket Number: 16356.723 (DC-01769)  
Customer No. 000027683

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re patent application of:  
Springer, David S., et al.

Serial No.: 09/313,436

Filed: May 17, 1999

For: METHOD AND APPARATUS FOR  
TRACKING BANNER ADVERTISING

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Group Art Unit: 3622

Examiner: Khanh H. Le

MAIL STOP AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Responsive to the Final Office Action, dated July 20, 2005, and the Advisory Action dated December 6, 2005, please consider the following remarks in connection with the pre-appeal brief request for review. Review of the final rejection is requested for the following reasons.

**1. The Rejection Of Claims 1 and 26, and their respective dependent claims, is not supported by a *prima facie* case of obviousness for Claims 1 and 26.**

Claims 1 and 26 and their respective dependent claims 4-5, 8-9, 27-28 and 30-31 are rejected under 35 U.S.C §103(a) as being unpatentable over *Guyot* (U.S. Patent No. 6,119,098) in view of *Jenkins* (U.S. Patent No. 6,285,983). A *prima facie* case of obviousness is missing, however, at least because there is no support for an obviousness rejection of the claimed subject matter as a whole because *Guyot* and *Jenkins* fail to disclose each element of the claims or suggest the missing elements.

The rejection admits that "*Guyot* does not specifically disclose the server is accessed by a computer manufacturer or that the credits given for viewing ads are discounts on advertised computer components from the manufacturer." and argues that it would have been obvious to one skilled in the art at the time the invention was made to apply *Guyot's* method to computer manufacturers to allow this type of merchant to use *Guyot's* method. Further, it would have been obvious to one skilled in the art at the time the invention was made to substitute to *Guyot's* credits given, discounts on advertised computer components for the manufacturers, in case these latter are involved, to provide credits in a form that is relevant to products that would obviously be likely to be advertised by such merchants, computer componets."

The rejection also admits that "*Guyot* does not specifically disclose the identifier is stored on a (the user's) hard drive (claims 8 and 30) or is imbedded in the user computer hardware (claim 1) and argues that in the analogous advertising art, *Jenkins* discloses that "*As is known in the art, cookie files may be installed by a web site server on the computer hard disk drive of a browsing consumer*" (see at least col. 1, lines 18-39).

The rejection also admits that "*Guyot* does not specifically disclose the information specific to the computer user includes one of incentives, bonuses and discounts on a plurality of goods, however it discloses targeted ads (abstract)" and argues that Official Notice is taken that it is well-known and customary to advertisements often include promotional offers, such as product or service discounts and vouchers to promote consumption." (includes grammatical errors from comments in Office Action).

The claimed invention provides a unique identifier imbedded in a system component by the manufacturer associated with a database including information specific to the user of the system provided by the manufacturer.

This is uniquely unlike the *Guyot* system which provides advertisements to subscribers based on a personal profile provided by that subscriber.

The unique identifier of the present invention is imbedded in a system hardware or software component during manufacture, which is uniquely unlike the cookie file installed on a hard disk drive of a browsing consumer in *Jenkins*.

There is no suggestion or supporting reference which teaches or suggests tracking information provided to a computer system from an advertisement database accessed by a computer manufacturer to provide discounts to users, based on a user receiving a predetermined number of advertisements that are tracked in a time period and associated with an identifier, as claimed, nor is there a teaching or suggestion of a unique identifier imbedded in a system component by the manufacturer associated with a database including information specific to the user of the system provided by the manufacturer.

**2. The Rejection Of Claims 6 and 29 is not supported by a *prima facie* case of obviousness.**

Claims 6 and 29 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Guyot* in view of *Jenkins*, and further in view of *Marsh et al.* (U.S. 5,848,397).

The rejection admits that "*Guyot* does not specifically disclose that if no matching criteria is found, the database transmitting one of generic advertisements and no advertisements," and argues that "*Marsh* discloses that default (generic) ads or no ads are displayed when no other criteria for display are met."

This rejection relies on a strained claim construction for the reasons set forth above relating to independent claims 1 and 26, from which claims 6 and 29 respectively depend.

Other reasons for the patentability of claims 1, 4-5, 8-9, 27-28 and 30-31 have been previously presented and will be maintained should the filing of an appeal brief become necessary.

Respectfully submitted,



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Dated: 12-19-05  
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